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54. (New) The system of claim 48, wherein the liquid cosmetic composition is a lip gloss.

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55. (New) The system of claim 36, wherein said computer stores information about a retail customer's selection and correlates the information with a file, created for the retail customer having a unique identifier.

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56. (New) The system of claim 48, wherein said computer stores information about a retail customer's selection and correlates the information with a file, created for the retail customer having a unique identifier.

✓  
57. (New) The system of claim 51, wherein said computer stores information about a retail customer's selection and correlates information with a file, created for said retail customer, and having a unique identifier.

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58. (New) The system of claim 52, wherein said computer stores information about a retail customer's selection and correlates information with a file, created for said retail customer, and having a unique identifier.

#### REMARKS

In the Office Action mailed December 5, 2002, the Examiner rejected claims 1-5, 7-9, 36, 37 and 40 in view of Brown, Krauss, Lombardi or combinations thereof. By way of the present amendment, the Applicants have clarified certain features of the claims to further distinguish over these references. Basis for the amendments can be found throughout the specification and claims as filed including, for example, at page 3 (1st full paragraph), page 5 (2d full paragraph), page 18 (first paragraph), the Example and the drawings. As such the claims are believed to be allowable and withdrawal of the present rejection in view of the same is respectfully requested.

Independent claims 1 and 36 have been amended to clarify that the "computer is programmed such that the entry of a particular color selection into the computer will retrieve recipe information about the selection for dispensing to achieve dispensing to achieve said color selection." The only reference relied upon by the Examiner to address the use of a computer is the Brown patent. However, while a computer is employed in the Brown machine, the purpose appears to be for assuring accurate control over dispensing of

ingredients, not for retrieving a programmed recipe. For example, at col. 1, the problem sought to be overcome by Brown appears to be that of inaccuracies that result from manual dispensing of ingredients. (See, col. 1, lines 18-28). A main object of the invention therefore is "to provide a custom blending machine for ingredients to obtain a cosmetic product that is highly accurate in dispensing each of the ingredients." (Col. 1, lines 42-45) (emphasis added).

The Brown patent does not teach that the computer is programmed with any recipe information. The patent teaches the use of a "programmable logic controller 26", at col. 3, lines 50-57. There is no teaching (express or inherent<sup>1</sup>), however, that the controller is programmed to have recipe information in it. Rather, the text at col. 3, lines 52-55 suggests that recipe information, if any, that the controller ever possesses is transient and the result of an external input: "[t]hese operating instructions can be delivered electronically via a device that measures a customer's specific skin requirements or via mechanical input from a human expert assigning an optimal formula." (emphasis added). Effective use of the Brown machine would thus require either separate hardware, or an "expert", neither of which is needed for operation of the claimed invention, where formulation recipes are already in the computer. In short, Applicants believe that the present pending claims are neither taught nor suggested by the references of record.<sup>2</sup> Withdrawal of all prior art rejections is thus respectfully requested.

Applicants also have added new claims 48-58, to recite the further distinguishing features. Neither Brown nor Krauss teaches or suggests radially disposed chambers, a user interface that is a monitor or screen, further computer functionality (e.g., that the computer is further programmed to provide a customer an option of adding effects, or it creates a file that is unique to a particular customer), or combinations thereof. As such those claims are also believed to present allowable subject matter.

Applicants disagree with the Examiner's withdrawal from consideration of claims 38, 39 and 41-47, believing that the Examiner has misapprehended the scope and legal effect

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<sup>1</sup>The Examiner can not rely upon the possibility that the Brown controller might store recipe information, as such would be an improper reliance upon principles of inherency, pursuant to which the Examiner bears the burden to show that such recipe storage would occur in virtually every scenario of the Brown machine operation. The above-quoted text at Col. 3 makes clear that such will not be the case. See, generally, *Finnigan Corp. v. ITC*, 51 U.S.P.Q.2d 1001 (Fed. Cir. 1999); and *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

<sup>2</sup>Applicants believe that the Examiner has failed to set forth a prima facie showing of obviousness of the claims in view of Krauss and Lombardi. Krauss is not directed to a computerized dispensing system, and appears to require that switches be manually set by an operator for each new composition. The Examiner has not provided any motivation to combine Krauss and/or Lombardi with Brown to arrive at the claimed invention as a whole. Rejections based upon those secondary references should be withdrawn.

of Applicants' previous Election of Species. Nonetheless, in view of the actions taken herein, Applicants have cancelled such claims in favor of prosecuting certain other claims in the present application and prosecuting the subject matter of claims 38, 39 and 41-47 by way of another continuing application.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

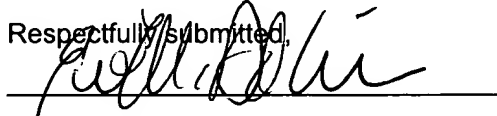
### Conclusions

In view of Applicant's amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicants request that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Amended) A custom liquid cosmetic dispensing system, comprising:

- a) a cosmetic dispensing system for dispensing a liquid cosmetic formulation in a liquid state into a package wherein it remains in a liquid state until user application ; and
- b) a computer for interacting with a retail customer to select a liquid cosmetic formulation and communicating information about a selection for use in controlling said dispensing system,

wherein said computer is programmed such that the entry of a particular color selection into the computer will retrieve recipe information about the selection for dispensing to achieve said color selection;

wherein said dispensing system is located in a housing that permits viewing of ingredients containers during selection and dispensing of said liquid cosmetic formulation.

✓ 36. (Amended) A custom nail polish dispensing system, comprising:

- a) a nail polish dispensing system; and
- b) a computer for interacting with a retail customer to select a nail polish formulation and communicating information about a selection for use in controlling said dispensing system;

wherein said computer is programmed such that the entry of a particular color selection into the computer will retrieve recipe information about the selection for dispensing to achieve said color selection.

✓ 48. (New) A custom liquid cosmetic dispensing system, comprising:

- a) a liquid cosmetic dispensing system that includes a plurality of chambers radially disposed about a common axis; and
- b) a computer for interacting with a retail customer to select a liquid cosmetic formulation and communicating information about a selection for use in controlling said dispensing system; and
- c) a user interface device including a video monitor or screen,

wherein said computer is programmed such that the entry of a particular color selection into the computer will retrieve recipe information about the selection for dispensing to achieve the ultimate desired color.

49. (New) The system of claim 5, wherein said chambers are radially disposed about a common axis.

50. (New) The system of claim 36, wherein said dispensing system includes a plurality of chambers radially disposed about a common axis and further comprises a user interface device including a video monitor or screen.

51. (New) The system of claim 36, wherein said computer is further programmed to provide said retail customer an option of adding effects such as sparkles, metal flakes, fragrance, textures or shapes.

52. (New) The system of claim 48, wherein said computer is further programmed to provide said retail customer an option of adding effects such as sparkles, metal flakes, fragrance, textures or shapes.

53. (New) The system of claim 1, wherein the liquid cosmetic composition is a lip gloss.

54. (New) The system of claim 48, wherein the liquid cosmetic composition is a lip gloss.

55. (New) The system of claim 36, wherein said computer stores information about a retail customer's selection and correlates the information with a file, created for the retail customer, having a unique identifier.

56. (New) The system of claim 48, wherein said computer stores information about a retail customer's selection and correlates the information with a file, created for the retail customer, having a unique identifier.

57. (New) The system of claim 51, wherein said computer stores information about a retail customer's selection and correlates information with a file, created for said retail customer, and having a unique identifier.

58. (New) The system of claim 52, wherein said computer stores information about a retail customer's selection and correlates information with a file, created for said retail customer, and having a unique identifier.